

## REMARKS

In the Office Action mailed March 17, 2005, Claims 1-5 are rejected under 35 U.S.C. §102(b), as being anticipated by U.S. Pat. No. 4,483,974 issued to Grögler et al. Claims 6-17 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,639,331 issued to Payne in view of U.S. Pat. No. 4,483,974 issued to Grögler et al. Claims 5 and 12 are rejected under 35 U.S.C. §112, second paragraph as being indefinite.

### Rejections under 35 U.S.C. §112, second paragraph

Claims 5 and 12 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite. The Examiner contends that the terms "thicker" and "more sponge-like" are relative terms which render the claims indefinite.

Applicants respectfully disagree with the Examiner regarding the terms "thicker" and "more sponge-like". However, in the interest of expediting prosecution of the instant application and in keeping with the spirit of the PTO's Patent Business Goals (PBG) 65 Fed. Reg. 54603 (September 8, 2000), Claims 5 and 12 have been cancelled thus obviating any grounds for rejection based upon those claims.

### Rejections under 35 U.S.C. §102(b)

Claims 1-5 stand rejected under 35 U.S.C. §102(b), as being anticipated by U.S. Pat. No. 4,483,974 issued to Grögler et al. Claim 5 has been cancelled, thus obviating any grounds for rejection based upon that claim. Applicants respectfully disagree with the Examiner's contention regarding Grögler et al.

Applicants respectfully remind the Examiner that as stated in MPEP §2131, to anticipate a claim, a reference must teach every element of that claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained

in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully contend that the Examiner has failed to point to where Grögler et al. do so.

The Examiner states at page 3, paragraph numbered 6 of the instant Office Action that, "(t)he coatings are applied to woven or knitted textile substrates by knife coating (col. 24, lines 14-21), which would substantially impregnate the fabrics." Applicants disagree and respectfully request the Examiner cite a reference so stating that application of a coating by knife coating, such as taught by Grögler et al., substantially impregnates the substrate or withdraw her rejection.

As those skilled in the art are aware, knife coating typically involves passing the substrate over one or more rollers having a knife suspended between the roller and the substrate. The knife removes excess coating from the substrate as it rapidly passes by. According to Webster's Ninth New Collegiate Dictionary (copy included for the Examiner's convenience), impregnating means causing "to be filled, imbued, permeated, or saturated" or "to permeate thoroughly". A process which passes a substrate over rollers and scrapes the substrate with a knife edge does not logically strike the Applicants to be a process which will cause the substrate to be filled, imbued, permeated, saturated or permeated thoroughly as required by the instant claims.

Therefore, Applicants respectfully request the Examiner reconsider and reverse her rejection of Claims 1-4 under 35 U.S.C. §102(b), as being anticipated by U.S. Pat. No. 4,483,974 issued to Grögler et al.

Rejections under 35 U.S.C. §103(a)

Claims 6-17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,639,331 issued to Payne in view of U.S. Pat. No. 4,483,974 issued to Grögler et al. Claim 12 has been cancelled, thus obviating any grounds for rejection based upon that Claim. Applicants respectfully disagree with the Examiner's contention regarding the teaching of the combined art.

As stated in MPEP §2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, citing *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

Clearly there is no such teaching, suggestion or motivation shown in the references in this case. Applicants query whether the teachings of Payne and Grögler et al. are combinable as Payne teaches, in the Abstract, to form a pool of liquid resin forming material and Grögler et al., as discussed above, teaches application of a coating to a substrate by knife coating. Applicants contend that forming a pool of a liquid material, as taught by Payne, and scraping off excess material, as taught by Grögler et al., are in opposition to each other and thus not combinable and even if combinable, fail to teach or suggest the instantly claimed invention.

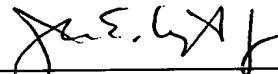
Therefore, Applicants contend that nothing in the combined teaching of Payne and Grögler et al. would lead one of ordinary skill in the art to the instantly claimed invention and respectfully request the Examiner reconsider and reverse her rejection of Claims 6-11 and 13-17 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,639,331 issued to Payne in view of U.S. Pat. No. 4,483,974 issued to Grögler et al.

### Conclusion

Applicants have cancelled Claims 5 and 12. Such amendment is to be construed as “truly cosmetic” and is not believed to narrow the scope of the claims or raise an estoppel within the meaning of *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., et al.*, 535 U.S. 722 (2002). Applicants also contend that such claim amendments add no new matter and find support in the specification.

Applicants submit that the instant application is in condition for allowance. Accordingly, reconsideration and a Notice of Allowance are respectfully requested for Claims 1-4, 6-11 and 13-17. If the Examiner is of the opinion that the instant application is in condition for other than allowance, she is invited to contact the Applicants' attorney at the telephone number listed below, so that additional changes to the claims may be discussed.

Respectfully submitted,

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